



# Taking Steps to Protect Your IP Rights

While IP protection in India continues to be a challenge, taking the proper steps to ensure your rights can go a long way. **Savitha Kesav Jagadeesan** and **Pavithra Ramasundaram** share the necessary tricks of the trade.

**R**ecent statistics have shown that protection and enforcement of intellectual property rights in India were and continues to be weak. India continues to defend its reputation of being a jurisdiction that has never produced an environment conducive to defend IPRs. The Global Intellectual Property Center International IP Index, run by the US Chamber of Commerce, has ranked India last and stated that it has the weakest intellectual property protection and enforcement environment. It is equally disappointing to note that though filings have increased, the annual reports of India's Office of the Controller General of Patent, Designs, Trade Marks and Geographical Indications show that the number of opposition proceedings and cancellation proceedings has decreased year after year.

Whether political changes will bring about changes to IP enforcement is yet to be seen, but we will examine the procedural formalities that should be invoked in order to protect IP rights in India.

## Stages in Enforcement

Devising an enforcement protocol could enhance aspects of policing IPR infringement and enforcing the attached and derived rights. As such, there is no clear or established protocol to follow in the event of infringement of rights, however given below are stages that is appropriate to be followed in the eventuality of an infringement, as suggested by the World Intellectual Property Organization:

- The enforcement pattern should ideally start with the

identification of violation.

- The owner should collect materials, including samples of infringing products, to proceed further with an action.
- After the preliminary investigation by the owner and identification of infringing materials/goods, the owner should approach legal counsel to analyze the evidence that has been collected and to ascertain the sufficiency of the same to approach the legal recourse against the infringer.
- It is important to note that the owner must frame his approach based on three aspects: whom the primary action is directed towards, such as retailers, e-commerce websites, etc; the nature of rights that have been infringed should be identified, such as trademarks, designs, copyrights, etc.; and what is the legal remedy that may be taken up.
- The IP owner may also seek a market search or internet search by engaging a private investigator to identify the products infringing his rights. In addition to the foregoing, an owner can also conduct a search in the Intellectual Property Office of India to ascertain if conflicting trademarks, inventions or designs exist on the register.
- The owner shall next ascertain the jurisdiction. IP infringement cases are generally instituted in the place of residence of the plaintiff or where the infringement takes place. A criminal complaint shall be filed before the local magistrate or police station within whose limits the complainant resides.
- The IP owner can also simultaneously serve a cease and desist notice on the infringing party in order to kickstart civil or criminal remedies. If the infringer fails to comply with the notice,

the owner may resort to the mentioned civil or criminal remedies such as initiating a suit for infringement, presenting a complaint in the local police station, etc.

- In addition to the civil and criminal remedies available under the IPR regime, the IP owner can also resort to the administrative remedies if he has unearthed conflicting marks, inventions, designs, etc in the Intellectual Property Register, such as filing a trademark opposition or rectification proceeding, a patent revocation proceeding, or a design cancellation proceeding.

- The IP owner can also trigger border enforcement measures to check infringements on the export and import of its products.

India has seen many landmark cases in this realm, including the 1994 Delhi case of *Daimler Benz and another v. Hybo Hindustan*, in which the defendants had adopted the trademark 'BENZ' in respect of goods such as undergarments. The plaintiffs contended that the Benz trademark was one of the most famous trademarks in the world used in respect of motor vehicles and that the defendant's trademark was confusingly similar to the plaintiff's trademark. Despite the completely different classes of goods and the plaintiff's averment of an honest and concurrent user, the Delhi High Court placed a great amount of emphasis on the cross-border reputation of the mark and its well-known mark status and ruled that the defendant's trademark is indeed deceptively similar to the plaintiff's well-known mark, restraining the defendant from using the impugned mark any further.

Another interesting case was that of *Troikaa Pharmaceuticals v. Pro Laboratories*. In this case, the plaintiff was the registered proprietor of a design of a D-shaped tablet; the defendant adopted and was dealing with a similar design. The plaintiff initiated a suit against the defendant, and the defendant, in turn, sought to cancel the plaintiff's registered design by stating that the plaintiff's design had already been published and lacks novelty. However, the High Court dismissed such claims and observed that though the D shape is not novel, application of the shape to tablets as such makes it novel and original, and hence granted an injunction restraining the defendants from using the impugned design.

The above are just some of the examples of how India's courts have taken the view that IPRs developed by a particular owner over a period of time are required to be upheld, and that infringements must be strictly dealt with.

## Conclusion

One can safely conclude that no right has a value attached to it unless it is followed by effective laws and equally strong enforcement of them. This is especially true of IPRs. IP rights are statutorily-recognized, jurisdiction-specific rights, but they have also led to principles that have recognized the need to understand cross-border rights and therefore allow for multiple jurisdictional fillings and bring forth a more singular IPR regime that allows for similar enforcement rights worldwide.

Robert M Sherwood perhaps put it best in his 1999 paper, "The Economic Importance of Judges," when he wrote that enforcement of IP rights "presents a significant direct link between judicial system performance and economic development. That is to say, the validity of intellectual property protection depends heavily on judicial system performance. For intellectual property rights to serve their purpose, effective judicial support is needed. A right without a remedy turns out to be an expensive fantasy. When judicial support for these



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specialized rights is feeble, mobilization of that natural resource falters, with considerable losses to the country." In India this, unfortunately, is the present status.

India's issue of having a weak enforcement system for IPRs does not stem from inadequate laws, but from a slow judicial process. For example, India is yet to implement across the board an electronic case management system which would allow for more speedy dispensation of pending cases. Another prominent setback is India's otherwise-lengthy judicial process. The judicial system speaks of speedy justice and despite the competent judiciary, a lack of judges and the growing number of cases being filed contribute to a slow process.

The IP offices, too, lack infrastructure to deal with a growing number of applications, and therefore there is no timely dispensation of these applications, leading to frustration among the IPR owner.

It is undeniable that the Indian judicial system does require an overhaul to deal with the blatant fallacy in the system. However, in equal measure, an IP owner also should understand and realize that so long as they are aware of the importance of IP rights to their business, they must not falter in upholding the very rights that they have registered or derived for themselves. The Indian system, despite its follies in its present form, is quite adequate to provide enforcement of one's rights so long as one knows how to work with the system. **AIP**



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